



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/716,257

11/18/2003

Robert C. Aaron

100202741-1

6466

22879

7590

07/07/2009

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT

PAPER NUMBER

3654

NOTIFICATION DATE

DELIVERY MODE

07/07/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
jessica.l.fusek@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. AARON, JEFFREY S. MCALLISTER,
and JAMES C. ANDERSON

Appeal 2009-003442
Application 10/716,257
Technology Center 3600

Decided:¹ July 2, 2009

Before LINDA E. HORNER, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Robert C. Aaron et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 9, 10, 12, and 14. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention pertains to a reel for receiving magnetic tape. (Spec. 3, ¶ [0009].) Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A reel comprising:
 - a hub;
 - a pair of flanges separated by the hub;
 - a guide member is positionable with respect to the hub such that the hub and the guide member cooperate to form a surface for receiving a magnetic tape; and
 - a securing mechanism formed in the pair of flanges and having a resilient member moveable for releasably securing a position of the guide member with respect to the hub.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Smith et al.	US 4,709,873	Dec. 1, 1987
Gavit et al.	US 6,889,927 B2	May 10, 2005

Before us for review is the Examiner's rejection of claims 1-4, 9, 10, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gavit and Smith.

ISSUES

Appellants contend that Gavit in view of Smith does not teach or suggest a securing mechanism formed in the pair of flanges, a securing mechanism that has a resilient member, or a resilient member that releasably secures the guide member with respect to the hub. (Reply Br. 2; *see also* App. Br. 10-12.) The Examiner found that Gavit discloses a securing mechanism with an engagement portion on the guide member, and receiving portions on the flanges. (Ans. 3.) The Examiner also found that Gavit's engagement portion is a resilient member moveable for releasably securing the guide member with respect to the hub. (*Id.*) The Examiner further found that Smith shows the engagement portion on the flange, and the receiving portion on the guide member. (*Id.* at 3, 5.) The Examiner then concluded that it would have been obvious to shift the location of Gavit's parts, as shown by Smith. (*Id.* at 4.) The Examiner alternatively concluded that it would have been obvious to utilize Smith's spring tab in Gavit's apparatus to releasably secure the guide member. (*Id.*) Thus, the first issue is:

Have the Appellants demonstrated that the Examiner erred in concluding that the rejected claims are unpatentable over Gavit and Smith because the combined references do not teach or suggest the recited securing mechanism?

Regarding claim 9, Appellants also contend that the references do not teach or suggest that the magnetic tape is windable onto the hub and guide member in a first direction of rotation and a second direction of rotation while the guide member is secured to the hub. (App. Br. 11-12.) Appellants also assert that the Examiner has ignored the pertinent language of claim 9. (*Id.*) The Examiner found that “all recited functions such as windable in first and second directions are deemed inherent to magnetic tape winding reels.” (Ans. 4; *see also* Final Rej. (Aug. 9, 2007) at 2.) Thus, the second issue is:

Have Appellants shown error in the Examiner’s inherency finding regarding the recitation of tape windable in first and second directions?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Gavit discloses a take-up reel 30 having a hub 40, a first flange 50, a second flange 70, and a receiver block 46. (Gavit, col. 8, ll. 50-60; fig. 5.) The flanges 50 and 70 are separated by the hub 40. (*See, e.g., id.*) The receiver block 46 has an outer surface 94 formed at the radius of the outer surface 42 of the hub 40 such that when the receiver block 46 is positioned in the hub (in the retracted state), the outer surfaces 94 and 42 of the receiver block and the hub, respectively, define a substantially cylindrical, substantially smooth winding surface for the tape. (*Id.* at col. 9, ll. 17-23; fig. 11b.)

2. Gavitt's "receiver block 46 is releasably retained in both the extended state and a retracted state by means of a common detent assembly in the form of a coil spring 102 and ball bearings 104 and 106." (Gavitt, col. 9, ll. 44-47; *see also* fig. 5.) Spring 102 is received in a bore 99 formed in the receiver block 46. (*Id.* at col. 9, ll. 47-48.) When in the retracted state, ball bearings 104 and 106 engage detent depressions formed in flanges 50 and 70 (such as detent depression 74 in flange 50). (*Id.* at col. 9, ll. 48-56.)

3. Smith discloses a device 19d to receive a threader pin 16 in a take-up reel 19. (Smith, col. 5, ll. 15-17; fig. 1.) Smith describes the device 19d as a plate that may be mounted above the top of the hub 19C of the take-up reel, and that may be mounted in cooperation with a first plate 120 which surrounds plate 19d. (*Id.* at col. 4, ll. 58-68.) Device (plate) 19d has threader pin receiver slot 11 and a biasing means housing cavity 102. (*Id.* at col. 5, ll. 1-4.)

4. Smith discloses an embodiment in which the biasing means is a leaf spring 106 having a raised part 110 that extends into slot 11. (Smith, col. 5, l. 67 – col. 6, l. 4, fig. 2.) Smith discloses another embodiment in which the biasing means is a ball 106A and coil spring 106B, and which is located in housing cavity 102A in the plate 19d. (*See id.* at col. 6, ll. 31-37, fig. 3.)

5. In either Smith embodiment, the biasing means releasably retains the threader pin 16. (Smith, col. 6, ll. 16-30, fig. 1 (threader pin rod 17 on threader pin 16 retained by leaf spring 106); col. 6, ll. 51-63 (threader pin 16 retained by ball 106A).)

6. The plate of Smith's device 19d is threaded so as to be received by plate 120. (Smith, col. 5, ll. 20-24; fig. 1.) Appellants admit that Smith's first plate 120 is one of a pair of spaced flanges on a take-up reel hub. (App. Br. 9, 10.) When device 19d, housing the biasing means, is threaded into plate 120, one of ordinary skill would consider the assembly to be a reel flange. Thus, Smith discloses a biasing means formed in a flange.

7. Appellants' Specification states:

When appropriately positioned, the hub and the guide member may cooperate to form a substantially continuous surface for winding magnetic tape from the source reel onto the take-up reel. The exemplary take-up reel also includes a mechanism for securing the cooperating position of the guide member with respect to the hub. By securing the guide member, the magnetic tape may be wound onto the take-up reel in either a clockwise direction or a counter-clockwise direction.

(Spec. 3-4, ¶ [0009].) Therefore, "a securing mechanism ... [is] configured to secure the guide member to the hub, such that the magnetic tape is windable onto the hub and the guide member in a first direction of rotation and a second direction of rotation while the guide member is secured to the hub," as recited in claim 9, when the hub and guide member form a substantially continuous surface.

PRINCIPLES OF LAW

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). It is the Appellants' burden to precisely define the invention, not that of the United States Patent

and Trademark Office. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (citing 35 U.S.C. § 112, ¶ 2). Appellants have the opportunity to amend the claims during prosecution, and broad interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *Prater*, 415 F.2d at 1404-05.

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). The scope and content of the prior art includes the explicit and inherent teachings of the prior art. *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)).

ANALYSIS

Claims 1-4

Appellants argue claims 1-4 as a group. (App. Br. 10-11.) We select claim 1 as the representative claim, and claims 2-4 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Appellants contend that Gavit in view of Smith does not teach or suggest a securing mechanism formed in the pair of flanges. (App. Br. 10; Reply Br. 2.) We first look to Appellants’ Specification to determine what

components comprise the recited “securing mechanism.” The Specification describes embodiments of securing mechanisms having tab members that interact with corresponding recessed regions or notch structures. (Spec. 7, ¶ [0016].) The Specification indicates that a securing mechanism may include both of the corresponding components. (*Id.* (“As another example, the securing mechanism 44 may include corresponding tab and notch structures located on the hub 30 and guide member 38.”).)

Gavit discloses a securing mechanism in the form of a pair of spring-biased ball bearings in the receiver block and detent depressions formed in the pair of flanges. (Fact 2.) Smith discloses two different securing mechanism embodiments – one having a spring-biased ball bearing and the other having a leaf spring – both located in the top flange. (Facts 3, 4.) To replace Gavit’s mechanism with Smith’s mechanism so as to have the spring components located in the pair of flanges would have been *prima facie* obvious as a simple substitution of one known element for another to obtain predictable results. *See KSR Int’l Co.*, 550 U.S. at 416 (“when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.”).

Appellants also argue that the combined references do not teach or suggest a resilient member. (App. Br. 11; Reply Br. 2.) Appellants appear to agree that Gavit’s spring/ball bearings and Smith’s leaf spring are resilient members. (*See* App. Br. 11.) It seems that Appellants’ position is that the claim requires that the resilient member be located in the flange, and that the prior art resilient members are not located in the flanges. (*See* App. Br. 11;

see also id. at 10 (Appellants arguing that Smith's leaf spring is in the hub, not the flange).) Even under Appellants' narrow construction of the claim, Smith does disclose resilient members formed in the top flange (*see* Fact 6), and, as discussed above, it would have been *prima facie* obvious to have spring components located in Gavit's pair of flanges.

In their Reply Brief, Appellants refer to the Examiner's statement that Gavit's spring and ball bearings (the "engagement portion" including elements 102, 104, and 106) are formed in the flanges, and argue that the Examiner has misconstrued the term "flanges." (Reply Br. 2 (citing Ans. 5).) The Examiner's statement appears to be an unintended error, as the Examiner also found elsewhere that Gavit's engagement portion is on the guide member (Ans. 3), and relied on Smith for the teaching that "the engagement portion is instead on the flange" (*Id.* at 5). Nonetheless, Appellants' assertion that Gavit lacks a securing mechanism formed in the pair of flanges (Reply Br. 2) is misplaced as the Examiner's rejection is based on the combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellants also assert that Gavit in view of Smith does not teach or suggest a resilient member that releasably secures the guide member with respect to the hub. (Reply Br. 2.) We discern no cogent explanation by Appellants as to why the combination is defective in this regard. (*See* Reply Br. 2-3.) As such, Appellants have not shown error in the Examiner's finding that Gavit teaches a resilient member (spring and ball bearings 102, 104, and 106) for releasably securing a position of the guide member 46 with respect to the hub (Ans. 3; *see also* Facts 1, 2).

Appellants have not shown that the Examiner erred in rejecting claim 1 as unpatentable over Gavit and Smith. Accordingly, we sustain the rejection of claim 1, as well as the rejection of claims 2-4, which fall with claim 1.

Claims 9, 10, 12, and 14

Appellants argue claims 9, 10, 12, and 14 as a group. (App. Br. 11-12.) We select claim 9 as the representative claim, and claims 10, 12, and 14 stand or fall with claim 9. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claim 9 recites: “a securing mechanism ... configured to secure the guide member to the hub, such that the magnetic tape is windable onto the hub and the guide member in a first direction of rotation and a second direction of rotation while the guide member is secured to the hub” Appellants assert that the Examiner ignored this language and that they “have reviewed Gavit and Smith and can find no location whatsoever that teaches or suggests [a magnetic tape windable in a first and second direction.]” (App. Br. 11-12.) Contrary to Appellants’ assertion, the Examiner did not ignore this claim language. Rather, the Examiner found that, “[i]n regard to claim 9, all recited structures are present, all recited functions such as windable in first and second directions are deemed inherent to magnetic tape winding reels.” (Ans. 4; *see also* Final Rej. (Aug. 9, 2007) at 2.) Where, as here, the Patent Office has reason to believe that a functional limitation is an inherent characteristic of the prior art, Appellants have the burden to show that the prior art does not possess that characteristic. *See In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971); *see also In re*

Spada, 911 F.2d 705, 708 (Fed. Cir. 1990) (“when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”). The Specification indicates that the tape is windable in two directions when the securing mechanism secures the guide member to the hub so that those components form a substantially continuous surface. (Fact 7.) When Gavit’s receiver block is restrained in the retracted position by the detent assembly, the block and hub form a substantially continuous surface. (See Facts 1, 2.) Thus, the Examiner’s determination of inherency is reasonable. Appellants do not offer any persuasive argument or evidence to rebut this determination.

Also as to claim 9, Appellants reiterate their assertions made in connection with claim 1 regarding the purported lack of a securing mechanism that is formed in the flanges and a resilient member. (App. Br. 12.) Appellants do not offer new arguments for claim 9, but rather rely on the arguments made in the context of claim 1. For the reasons discussed above, we have found these arguments unpersuasive.

Appellants have not shown that the Examiner erred in rejecting claim 9 as unpatentable over Gavit and Smith. Accordingly, we sustain the rejection of claim 9, as well as the rejection of claims 10, 12, and 14, which fall with claim 9.

CONCLUSIONS

We conclude that the Appellants have not demonstrated that the Examiner erred in concluding that the rejected claims are unpatentable over

Gavit and Smith. We also conclude that the Appellants have not shown error in the Examiner's inherency finding regarding the recitation in claim 9 of tape windable in first and second directions.

DECISION

The decision of the Examiner to reject claims 1-4, 9, 10, 12, and 14 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Klh

HEWLETT PACKARD COMPANY
P.O. BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400